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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,411	10/16/2001	George H. Kitchen III	70008-9101	5840

5179 7590 07/16/2002

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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/16/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/98/411

Applicant(s)

KITCHEN et al

Examiner

MEDLEY

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-66 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-66 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1714

DETAILED ACTION

The amendment filed January 31, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The ^{keep}insertion at page 1, in the paragraph beginning on line 8, in line 12---and act as a strong demulsifier--- after "microbial growth"; the ^{keep}insertion of "usable" in the last paragraph on page 4; at ^{keep}page 8, line 2², the insertion of -- 0.05--; at ^{keep}page 9, the insertion of ---0-.005--- and ---0.3---; the deletion at ^{keep}page 12, on line 6, in lines 8 and 9 and at line 13; the insertion at page 13, in table 2, in line 1 of table 2; the insertion on page 13, under table 2 for ---*Percent change; the ^{keep}deletion of "'462 patent and the insertion of the prior art at page 13, in lines 15 and 20; the deletion at page 14, line 2, the ^{drop}deletion and insertion at line 3 of page 14; and at ^{drop}page 14, the third paragraph, the deletions of "0.u" and optical units" in lines 2-5 and the insertion of ---percent---; at ^{keep}page 14, line 2 of paragraph 3, the deletion of "'462 composition" and the insertion of --prior art sample---; and in the ^{keep}third paragraph, line 7, of page 14, the deletion of '462" and the insertion of --- prior art--.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1714

141p Claim 38 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The 0.005 and approximately 0.150" limitation is considered as new matter because the said relative proportion was not found in the disclosure and claims as originally filed. Applicants did not point out to the examiner the specific location in the instant application of the said limitation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

141p Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 (and its dependent claims) are indefinite because it does not find support from claim 1 for the amine component. In the interest of compact prosecution claim 3 (and its dependent claims 4-5) will be treated on the merits as depending directly and indirectly, respectively, from claim 2. Applicant is required to clarify the record as to the claim dependency of claims 4 and 5. *141p* Claims 43 and 44 are indefinite and confusing for the second additional lubricant because It is unclear if applicant intended only additional biocide or metal deactivator, or if additional lubricant is added to the lubricant that is added at claim 19 from which claims 43 and 44 depend. Clarification to the record is requested.

Art Unit: 1714

^{imp}
Claim 3 (and dependent claims 4-5) recites the limitation "amine...atoms" in lines 3-5.

There is insufficient antecedent basis for this limitation in the claim.

The requested amendments for page 6, line 7 and page 8, line 13 and claim 37 have been entered of record.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen III 4,609,379 and 4,585,462 in view of Valentine et al (Valentine) 5,5⁵⁰₇₁₄ and Hinkamp 4,336,033.

Kitchen, III teaches a fuel additive comprising stabilizer, dispersant, biocide, lubricant, solvent, and metal deactivator '379, note abstract, column 2, lines 23-39; and '462, note abstract, column 2, line 61 to column 4, lines 31, but is silent to applicant's required iron organometallic compound.

It is the examiner's position that the addition of an iron organometallic compound to the additive of Kitchen would be obvious to the artisan in the art in view of the teachings of Valentine and Hinkamp. Valentine teaches the addition to gasoline or diesel fuel, column 8, lines 50-52, manganese, iron, or other metal compounds e.g. ferrocene, iron pentacarbonyl, column 13, lines

Art Unit: 1714

3-13 and 61-64 to reduce emissions of pollutants e.g. hydrocarbons, carbon monoxide, etc, column 12, line 66 to column 13, lines 1-3. Hinkamp is relied on as a teaching reference that iron pentacarbonyl is added to fuel additives normally employed in fuel composition, e.g. gasoline, column 2, lines 35-65.

It would be obvious to the artisan in the art to add the iron pentacarbonyl compound of the secondary references to the fuel additive of the primary reference in the absence of evidence of record to contrary. In re Kerkhoven 205 USPQ 1069 (CCPA 1980). It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. In re Susi 169 USPQ 423, 426 (CCPA 1971); In re Crockett 126 USPQ 186, 188 (CCPA 1986).

A review of the experimental data and results presented in the instance application indicate that the data and results are confusing and unclear. It is unclear from the record as to what comparison were made and what were the results from the said comparisons. Therefore the data cannot be relied upon as evidence of record to show conclusive unexpected results and to rebut the rejection made of record.

The prior art cited but not relied upon further teach fuel additives comprising components of the same nature as applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:00 pm.

Art Unit: 1714

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is 872-9310 and for After Finals 703-872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

MMedley:evh

6/29/02


MARGARET MEDLEY
PRIMARY EXAMINER